

By



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,682	07/15/2003	Sarah Elizabeth Witt	450110-04642	7074

7590 07/12/2005

FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,682

Applicant(s)

WITT ET AL.

Examiner

Jeffery A. Brier

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/3/04 & 7/15/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The disclosure is objected to because of the following informalities:

The list of components forming emotion engine 100 at page 5 line 35 to page 6 line 5 should be amended to include IPU 118 even though it is described at page 7 lines 19-22.

The list of components forming local memory 212 at page 7 lines 27-28 should be amended to include Z buffer 215 even though it is described at page 8 lines 20-32.

At page 12 line 24 HDD 900 should be HDD 800.

At page 17 line 4 1510 should be 1520. Appropriate correction is required.

Drawings

3. The drawings are objected to because figures 6 and 7 have handwritten reference numerals which have some legibility concerns. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

Art Unit: 2672

appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This application is directed to a useful, concrete, and tangible result, however, these claims are not. Claims 12-15 are a program per se. Claims 1-16 are directed to image manipulations and do not claim a practical utility since the term "for display" is intended use rather than an actual post solution activity. *State Street Bank & Trust Co. v. Signature Financial Group Inc.* (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). *AT&T Corp. v. Excel Communications Inc.*

Art Unit: 2672

(CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in State

Street:

Under *Benson*, this may have been a sufficient indicium of nonstatutory subject matter. However, after *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

Step ii is misdescriptive because the specification did not describe manipulating the contiguous group of graphics primitives, see page 14 lines 15-20 which describes generating the foreground image rather than manipulating graphics primitives.

Steps iii and iv are incomplete because the specification describes alpha blending the background with the foreground and alpha blending the edge of the primitive with the background. Thus, the use of the term superposing in step iv is misdescriptive of the type of combining being performed and the use of the term filtering in step iii is incomplete with regards to the type of filtering being performed.

Step v is incomplete because the specification does not describe superposing original image over the primitive processed image, see page 16 lines 29-35.

Claim 2:

Step viii is misdescriptive of the replacing since page 16 lines 29-35 discusses replacing more than just the edge regions with the softened version of the combine image.

Claim 8:

At lines 5-6 a high degree of transparency is claimed while the specification at page 15 lines 29-32 describes semitransparency. Semitransparency has a different scope than high degree of transparency. Thus, either the claim needs amending or the specification needs amending to provide antecedent basis for the claim.

Claim 9:

At line 5 "said setting step" lacks antecedent basis in the claim. At line 4 "said display plane" lacks antecedent basis in the claim.

Claims 9 to 11:

These claims are not described in the specification. Refer to page 14 lines 21-23, line 31 to page 15 line 2. Thus, these claims do not clearly claim the described invention.

Claims 12 to 15:

These claims are incomplete because program code do not carry out a method independent of an apparatus such as a computer, a programmable processor, etc. Claim 12 is also incomplete because a readable medium embodying the instructions of the program code is necessary.

Claim 16:

This claim has the same problems identified above for claim 1 since it is an apparatus versions of method claim 1.

Art Unit: 2672

8. Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims are not described in the specification. Refer to page 14 lines 21-23, line 31 to page 15 line 2. These claims do not enable one of ordinary skill in the art to practice the method of these claims without undue experimentation. What transformation is applied to a source image to generate the original foreground image. The brevity of the claim would force one of ordinary skill in the art to apply many transformations but one of ordinary skill in the art would not be able to determine the correct transformation because the end result of the transformation has not been disclosed. How much of a non-zero degree of transparency is the transparency component and how would one of ordinary skill in the art know which non-zero transparency to select? How would one of ordinary skill in the art know which non-zero transparency to select based upon the angle between the image regions and the display plane? How would one of ordinary skill in the art know which non-zero transparency to select and when to apply it based upon if said primitive does not form part of a contiguous parallel set of primitives?

Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jean-Pierre Braquelaire, Anne Vialard, A New Antialiasing Approach for Image Compositing, The Visual Computer 13(5): 218-227 (1997), Publisher: Springer-Verlag GmbH. This article may be found at: <http://citeseer.ist.psu.edu/223444.html>.

Watanabe et al., U.S. Patent No. 5,233,332 teaches page turning effect.

Dorbie, U.S. Patent No. 6,614,445, teaches rendering an original image into a frame buffer, retrieving the rendered original image from the frame buffer, filtering the retrieved original image, and then blending the filtered original image with a background image stored in the frame buffer, however, it appears this reference does not teach blending the original image with the filtered original image since the original image is stored in the frame buffer at a size larger than the filtered original image.

10. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

Art Unit: 2672

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier
Primary Examiner
Art Unit 2672